

REMARKS / DISCUSSION OF ISSUES

Claims 1-7 and 8-22 are presently under consideration. Claims 1, 8, 15 and 20 are independent claims.

Unless indicated to the contrary, claims are amended for non-statutory reasons such as to address antecedent basis issues created as a result of amendments to previous claims.

Objection to the Claims

The objection to claim 17 is moot in view of the present amendment. Withdrawal of this objection is solicited.

Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Simmons, et al.* (Re 36,839). For at least the reasons set forth herein, Applicants respectfully submit that these claims are patentable over the applied art.

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary

skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1, as amended, is drawn to a system and features a clock control module, and: “...a control circuit configured to provide a hibernate signal to the clock control circuit.”

Applicants respectfully that the applied art fails to disclose at least the noted feature of claim 1. Notably, while the reference to *Simmons, et al.* discloses deactivating a functional block, there is no teaching or suggestion of a control circuit configured to provide a hibernate signal to the clock control circuit. Therefore, *Simmons, et al.* cannot anticipate claim 1. Accordingly, because the reference fails to disclose at least one feature of claim 1, this claim is patentable over the applied art. Moreover, claims 2-6, which depend from claim 1, are patentable for at least the same reasons as claim 1. Allowance is earnestly solicited.

Rejections under 35 U.S.C. § 103

Claims 3, 5 and 7-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Simmons, et al.* in view of *Knee, et al.* (U.S. Patent 6,930,060). For at least the reasons set forth herein, these claims are patentable over the applied art.

i. Claim 8 is patentable over the applied art

Claim 8, as amended, is drawn to a system and features, inter alia: “...a control circuit configured to provide a hibernate signal to the clock control circuit.”

Applicants respectfully submit that the applied art fails to disclose at least the noted feature of claim 8. To wit, as described in connection with claim 1 above, the reference to *Simmons, et al.* fails to disclose this feature. The Office Action does not assert that *Knee, et al.* cures this deficiency; and Applicants submit that the reference fails to cure this defect. Notably, Applicants have reviewed the reference and have not uncovered the teaching of the noted features.

ii. The Combination of References is Improper

Analysis of obviousness under 35 U.S.C. §103 requires determination of the scope and content of the prior art, the differences between the prior art, and the claims at issue, and the level of ordinary skill in the pertinent art. *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303, 311 (1983) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (CAFC 1966)). Moreover, there must have been something present in the teachings of the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W.L. Gore & Associates* at 311 (citing *In re Bergel* 130 USPQ 206, 208 (CCPA 1961)); and *In re Spinnoble* 160 USPQ 237, 244 (CCPA 1969)).

Furthermore, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a reason, suggestion or motivation do so. The reason, suggestion or motivation may come from references themselves; from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in the particular field; or from nature of the problem to be solved to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.* 37 USPQ2d 1626 (CAFC 1996). Moreover, prior knowledge in the field must be supported by tangible teachings of reference materials. *Cardiac Pacemakers Inc. v. St. Jude Medical Inc.* 72 USPQ 2d 1333, 1336 (CAFC 2004). However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability. *Sensonics Inc. v. Aerosonics Corp.*, 38 USPQ 2d 1551-1554 (CAFC 1996), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303. Moreover, the determination of obviousness cannot be based on the hindsight combination of components selectively

culled out from the prior art to fit the parameters of the claims at issue. *Crown Operations International Ltd. v. Solutia Inc.* 62 USPQ2d 1917, 1922 (CAFC 2002).

As is known, the initial burden of establishing that the requisite motivation to combine references lies with the Office. Applicants respectfully submit that the Office has not met the initial burden of establishing the requisite motivation to combine references. To this end, the Office Action states: “At the time of the invention, it would have been obvious to one of ordinary skill in the art, that Simmons’ power saving means are applicable to optical mice, especially ones that [are] powered by a battery.” No other basis to combine the references is provided.

Applicants respectfully submit that the quoted portion of the Office Action is a conclusory and perfunctory statement that the references are properly combinable, but does not afford the reason, suggestion or motivation to combine the references as specifically required by germane law. Therefore, and for at least the reasons set forth above, Applicants respectfully submit that because a proper combination of references has not been established, the rejection under 35 U.S.C. § 103(a) is wholly improper and should be withdrawn. As such, Applicants respectfully submit that claims 3,5 and 7-22 are patentable over the applied art.

iii. The Office Action Fails to Comply with MPEP § 706

Applicants respectfully submit that a proper rejection within the guidelines of MPEP § 706 has been provided. A basic goal of examination as set forth in MPEP § 706 is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. Applicants respectfully submit that a rejection has not been clearly articulated.

The rejection of claims 3, 5, 7, 9, 10 and 13 are baseless, merely providing an assertion of that which is allegedly known in the art. For example, the Office Action merely alleges that a slower second functional speed is commonly used in a sleep or suspend mode. The required basis in the applied art is not provided, nor is evidence

offered in support that this is known to one of ordinary skill in the art. If the evidence is based on the personal knowledge of the Examiner, Applicants respectfully request that an affidavit under 37 C.F.R. 1.104(d)(2) be provided along with the requisite teaching, suggest or motivation to combine the references. If such properly combinable evidence is not provided, Applicants respectfully submit that this rejection is improper and should be withdrawn. Moreover, because Applicants have been deprived of the opportunity to refute the alleged evidence of obviousness, should this evidence be offered, Applicants respectfully submit that this should be done in a subsequent non-final office action.

Similarly, the rejection of claims 15-19 is a mere allegation that because the references to *Simmons, et al.* and *Knee, et al.* teach the features of claims 1-14, the methods of claims 15-19 are obviated by these references. The Office Action fails to cite the disclosure of the noted features of claims 15-19 with specificity as required. Moreover, because the motivation to combine references is not provided as to these claims, the rejection is also improper. Applicants respectfully request that the Examiner articulate with clarity the disclosure of each and every feature of claims 15-19 in the applied art, or withdraw the rejection. Moreover, because Applicants have been deprived of the opportunity to refute the propriety of the motivation to combine references, should this motivation be offered, Applicants respectfully submit that this should be done in a subsequent non-final office action.

Response to Examiner's Note

Applicants have reviewed the Examiner's note on page 5 of the Office Action. As discussed above, Applicants respectfully submit that in certain instances the Office Action has not clearly articulated a rejection by failing to provide with specificity those teachings of the applied art, which the Examiner alleges disclose the claimed features. Applicants submit that the mere citation of references without a clear articulation of a rejection based on specific teachings of the applied art does not suffice as a proper rejection.

Furthermore, and in keeping with the referenced section of the MPEP, and uncited examination guidelines and portions of the MPEP, the citation of columns and line numbers in the applied art is not for the convenience of Applicants, but is necessary to fulfill the initial burden of establishing a proper art-based rejection of the claims under examination. A necessary corollary is by not providing such clear articulation of a rejection including citation of reference characters, lines and columns in the applied art, the initial burden of establishing a rejection cannot be effected.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

Avago Technologies, Inc.

A handwritten signature in black ink, appearing to read 'William S. Francos', is written over a horizontal line.

by: William S. Francos (Reg. No. 38,456)

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